

REMARKS

I. April 19, 2005, Interview

Applicants thank Examiner Qazi for the courtesy extended to Applicants' representatives in an in-person interview on April 19, 2005. During the interview, the rejections under 35 U.S.C. § 112, first paragraph, were discussed. Applicants pointed to support in the specification for the claimed "C1-C8 aminoiminoalkyl groups" and "C3-C20 rings." The Examiner indicated that she found support for "C1-C8 aminoiminoalkyl groups" sufficient. Regarding "C3-C20 rings," however, the Examiner suggested Applicants consider amending the claims to recite "phenyl" or any other groups for which Applicants find support. Applicants express their appreciation that the Examiner indicated her willingness to consider such an Amendment after final rejection. In order to expedite prosecution, Applicants include such an Amendment in this Request for Reconsideration, and respectfully submit that the Amendment places the claims in condition for allowance.

II. Status of the Claims

Claims 11-100 are pending. Claims 13 and 43-100 have been withdrawn by the Office as drawn to a non-elected invention. Office Action, page 2. Claims 11, 12, and 14-42 are under consideration. *Id.* Claims 11, 12, and 14-42 stand rejected under 35 U.S.C. § 112, first paragraph. *Id.* at 3-6.

The proposed amendment addresses the Examiner's suggestions made during the interview of April 19, 2005. In particular, the proposed amendment replaces the recitation in claim 11 of "C₃ to C₂₀ rings, optionally chosen from aromatic rings, and optionally comprising at least one heteroatom chosen from halogens, nitrogen, oxygen,

and sulphur “ with “phenyl groups optionally substituted by at least one group chosen from halogens, C₁ to C₄ alkyl groups, C₁ to C₄ alkoxy groups, and hydroxyl groups.” Support for this amendment is found in original claim 12, in the specification on page 5, lines 5-7, and in the examples given on pages 5-7. In addition, specific examples of compounds of formula (I) in which one or more of R₁, R₂, or R₃ is a substituted phenyl include those compounds disclosed on page 6, lines 9-12, page 7, lines 3-11, and page 7, lines 26-28.

The change made to claim 11 is also proposed for claims 43-45, and 97-99. In addition, Applicants propose amending claims 43-45 and 97-99 to include the language found in claim 11 regarding the proviso and that the composition further comprises at least one additive. Support for the proviso was described in detail in Applicants response filed September 29, 2004. Support for the reducing composition further comprising at least one additive is found in claims 20 and 74, now canceled, and in the specification on page 11, line 6 to page 14, line 9, and in original claim 7.

The proposed amendments eliminate the recitation of “heterocycles” from claims 12 and 66, and those compounds including heterocycles from claims 14 and 68, in order to makes those dependent claims consistent with the claims from which they depend. Likewise, the dependency of claims 75-77, 79, 80, and 90 is changed to claim 45 in view of the cancellation of claim 74 and the incorporation of the subject matter of claim 74 into claim 45.

No new matter would be added by these amendments.

III. Request for Rejoinder

Claim 45 is a process claim which, in view of the proposed amendments, would include all of the limitations of composition claim 11. Claims which depend from claim 45 recite the same subject matter as the claims which depend from composition claim 11. As provided for in M.P.E.P. § 821.03, Applicants respectfully request the Examiner rejoin and fully consider these process claims upon finding the composition claims allowable. Applicants also respectfully request the Examiner consider rejoining claims 44, 45, and 97-100. These claims are drawn to compositions/compounds (claims 44, 45, and 100) that fall within the scope of claim 11. Claim 97 is a process claim of the same scope as claim 43. Claims 97 and 98 are kit claims that include the compositions of claims 11 and 43.

IV. Rejection under 35 U.S.C. § 112, first paragraph, written description (new matter)

Claims 11, 12, and 14-42 are rejected under 35 U.S.C. § 112, first paragraph, as allegedly failing to comply with the written description requirement. Final Office Action, page 3. According to the Examiner, "C1-C8 aminoiminoalkyl groups" and "C3-C20 rings" "are not described in the specification and therefore considered as new matter." *Id.* Applicants respectfully traverse this rejection with respect to "C1-C8 aminoiminoalkyl groups" and submit that the rejection with respect to "C3-C20 rings" is moot in view of the amendments to the claims.

In the April 19, 2005, interview, Applicants' representatives pointed out that the combination of different substituents set forth on pages 3-4 of the specification provides support for "C1-C8 aminoiminoalkyl groups." The specification provides a limited list of

possible substituents at page 3, line 18 to page 4, line 1. One of these substituents is imino. See page 3, line 20. The specification goes on to state that the substituent may be further modified by carrying “*one or more* hydroxyl, carboxyl, *amino*, amido, halogen, *C1-C8 alkyl* or C1-C8 alkoxy radicals.” Specification page 4 at lines 1-4 (emphasis added). Thus the specification clearly contemplates R1, R2, and R3 groups in which an imino (N=C) substituent is modified by carrying both an amino (NH₂) and a C1-C8 alkyl. The specification at page 7, lines 24-25, provides a particular embodiment in which the C1-C8 alkyl is methyl. It is well settled that the “subject matter of the claim need not be described literally (*i.e.*, using the same terms or *in haec verba*) in order for the disclosure to satisfy the description requirement.” M.P.E.P. § 2163.02. In addition, C1-C8 aminoiminoalkyl groups have support in originally filed claim 3, by the recitation of “[*(aminoiminomethyl)amino*]imino-methanesulphinic acid.” The Examiner stated during the interview that she found this support sufficient.

Applicants’ representatives also noted in the April 19 interview that reducing compositions in which R1, R2, and R3 represent an aromatic or nonaromatic C3 to C20 ring are disclosed in the specification at page 3, lines 9-24, especially line 24, and were recited in original claim 1. In addition, there are several compounds comprising C3-C20 rings disclosed in the embodiments set forth on pages 5-7 (e.g., those compounds containing a phenyl, a pyridyl or a quinolyl group,) and the working example of lotion 2 on page 16 includes a C3-C20 ring (phenyl.) The specification therefore discloses not only the genus of C3-C20 rings, but also provides several embodiments and a working example comprising a ring. In the interview, the Examiner maintained her position that the claims were, in her opinion, too broad, and suggested amending “C3 to C20 rings”

to “phenyl.” Solely to expedite prosecution, the proposed amendment replaces “C3 to C20 rings” with phenyl groups optionally substituted. Support for the amendment is found in original claim 12, in the specification on page 5, lines 5-7, and in the examples given on pages 5-7. Specific examples of compounds of formula (I) in which one or more of R1, R2, or R3 is a substituted phenyl include those compounds disclosed on page 6, lines 9-12, page 7, lines 3-11, and page 7, lines 26-28. Applicants therefore respectfully submit that this amendment is supported in the specification as filed.

V. Rejection under 35 U.S.C. § 112, first paragraph, enablement

The Office also rejects claims 11, 12, and 14-42 under 35 U.S.C. § 112, first paragraph, as allegedly failing to comply with the enablement requirement. Final Office Action, page 4. The Office asserts that “there is no related description in the disclosure where one skilled in the art would be able to make and use of the wide range of the compositions of the compounds of formula (I) as claimed in claim 11 without undue experimentation.” *Id.* The Office comments briefly on the factors which must be considered in determining whether undue experimentation is required to practice the claimed invention then conclude that “[o]ne skilled in the art would have no idea how to practice the invention.” *Id.* at 5-6.

While Applicants strongly disagree with the Office’s position, the Examiner noted in the April 19, 2005, interview that amending the claims to recite “phenyl,” as she proposed, would also likely obviate this enablement rejection. As discussed, Applicants have amended the claims to recite phenyl groups optionally substituted in an effort to expedite prosecution. Applicants respectfully submit that the specification provides sufficient guidance to satisfy the enablement requirement. First, the state of the art was

highly advanced at the time the invention was made. As the specification acknowledges on pages 1-3, reducing compositions for deformation of hair were known in the art. The prior art compositions, however, have the undesirable effect of damaging the hair fiber, and in addition, have an unpleasant smell. Although the claims encompass a number of reducing compositions, all of these compositions comprise reducing agents that share a common core structure. The specification also provides on pages 5-7 many different species of reducing agents with this core structure. References that describe generally how to make the compounds of formula (I) are set forth in the specification on page 5, lines 11-23. Further, Applicants provide a working example with one of these reducing agents.

VI. Conclusion

Applicants respectfully request entry of this Amendment under 37 C.F.R. § 1.116. They submit that the proposed amendments do not raise new issues or necessitate the undertaking of any additional search of the art by the Office. Further, Applicants submit that the entry of the amendment would place the claims in condition for allowance, or would place the application in better form for appeal, should the Office dispute the patentability of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Jessica H. Roark
JESSICA H. ROARK

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By: Reg No 54,869 For: _____
Anthony C. Tridico
Reg. No. 45,958